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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,905	02/02/2001	Koichi Yoneta	58799-031	8110

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McDermottm Will & Emery
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,905

Applicant(s)

YONETA ET AL.

Examiner

Kambiz Abdi

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-18 have been examined.

Claim Objections

2. Claim 2 is objected to because of the following informalities: Claim 2 states "m marketer...", which does not make sense. Examiner suggests changing the "m" to "the" to make the claim clear. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
4. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) The term "key data" in independent claims 1, 2, 11-16 is used by the claims to mean "data" while the accepted meaning is "decryption key". The term is indefinite because the specification does not clearly redefine the term "key data". The examiner requests clarification.
5. Dependent claims 3-10 and 17-18 are unclear in that they depend from unclear independent claims.
6. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear to the examiner of which storage medium the applicant is referring when the phrase "storage medium owner..." is used.

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7. Claims 1-2 and 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear to the examiner where "the digital information" is located or stored.
8. Dependent claims 3-10 and 17-18 are unclear in that they depend from unclear independent claims.
9. Also claims 17-18 are not clear as they fail to particularly point out and distinctly claim subject matter which applicant regards as the invention. It is not clear to the examiner what "unique IC card key data" is used to copy "key data" from one storage medium to another. There is nothing that distinguishes one data from the other; further clarification is requested.
10. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For further clarify the claims, applicant is encouraged to reword the claims to put them in better position for examination. Corrections and clarifications are requested.
11. Examiner will examine the claims as they have been presented as best as it could be interpreted by the examiner at their broadest meanings.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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13. Claims 1-2 and 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,226,618 to Edgar Downs.

14. As per claims 1 and 2, Downs discloses a digital information sales method, comprising:

- a step for storing to a first storage medium key data indicating permission to use the digital information (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68); and
- a step for storing to the first storage medium a program having a function for storing a fee for using the digital information to a marketer area of the storage medium that cannot be accessed by the storage medium owner when copying key data from the first storage medium to a second storage medium using the digital information controller (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68, column 24, lines 1-68, column 25, lines 1-68, column 39, lines 25-68, column 40, lines 1-23, column 47, lines 26-68, and column 46, lines 1-26), and
- a function for controlling the digital information controller to send fees stored to m marketer area to the marketer when communicating using the first storage medium (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68, column 24, lines 1-68, column 25, lines 1-68, column 39, lines 25-68, column 40, lines 1-23, column 47, lines 26-68, and column 46, lines 1-26).

15. As per claims 11-16, A digital information sales method, apparatus, and medium comprising:

- a step for storing to a first storage medium key data indicating permission to use the digital information (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68); and
- a step for storing to the first storage medium a program having a function for controlling the digital information controller so that key data is copied in an unusable state when copying key data from

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the first storage medium to which the key data is written to a second storage medium using the digital information controller.

- a function for controlling the digital information controller to access the digital information marketer through a communications means when playing back the copied digital information to convert the key data stored to the second storage medium to a usable state (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68, column 24, lines 1-68, column 25, lines 1-68, column 39, lines 25-68, column 40, lines 1-23, column 47, lines 26-68, and column 46, lines 1-26); and
- a step for sending information for setting key data stored to the second storage medium to a usable state when access is made using the second storage medium containing unusable-state key data and the digital information usage fee is paid (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68, column 24, lines 1-68, column 25, lines 1-68, column 39, lines 25-68, column 40, lines 1-23, column 47, lines 26-68, and column 46, lines 1-26).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 3-10 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,226,618 to Edgar Downs in view of U.S. Patent No. 5,892,900 to Karl L. Ginter.

18. As per claims 3 and 4, Downs discloses all the limitations of claims 1 and 2;

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- What Downs does not clearly disclose is storing a fee for using the digital information to a marketer area that cannot be accessed by the storage medium owner when copying key data from storage medium N-1 (where N is an integer of 3 or more) to storage medium N. However, Ginter disclose storage of fees in a VDE for further processing as the digital content is utilized by the user (See Ginter Column 17, lines 41-68, column 18, lines 1-38, column 23, lines 45-68, column 36, lines 27-43, and column 63, lines 27-68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter to achieve a more efficient and accurate accounting and better control over the usage of the traveling digital content rights.
19. As per claims 5 and 6, Downs discloses all the limitations of claims 3 and 4;
- What Downs does not clearly disclose is said program has a function for controlling so as to store said usage fee to said marketer area of storage medium N. However, Ginter disclose storage of fees in a secure section of the VDE for further processing as the digital content is utilized by the user (See Ginter Column 17, lines 41-68, column 18, lines 1-38, column 23, lines 45-68, column 36, lines 27-43, and column 63, lines 27-68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter to achieve a more efficient and accurate accounting and better control over the usage of the traveling digital content rights.
20. As per claims 7 and 8, Downs discloses all the limitations of claims 3 and 4;
- What Downs does not clearly disclose is said program has a function for controlling so as to compare a user-marketer transaction count from storage medium N and from storage medium N-1, and storing said usage fee to the marketer area of the storage medium having the higher transaction count. However, Ginter disclose storage of fees in a secure section of the VDE for further processing as the digital content is utilized by the user (See Ginter Column 17, lines 41-68, column 18, lines 1-38, column 23, lines 45-68, column 36, lines 27-43, and column 63, lines

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27-68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter to achieve a more efficient and accurate accounting and better control over the usage of the traveling digital content rights.

21. As per claims 9 and 10, Downs discloses all the limitations of claims 1 and 2;

- What Downs does not clearly disclose is said program has a function for controlling an ATM terminal to send money information stored in the marketer area of the storage medium to the digital information sales apparatus when a storage medium having a usage/purchase amount stored in the marketer area is inserted to the ATM machine. The examiner takes Official Notice that making a payment of a usage/purchase amount via an ATM system is well established in the e-commerce industry. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to utilize this method for optimizing the process of payment.

22. As per claims 17 and 18, Downs discloses all the limitations of claims 1 and 2;

- What Downs does not clearly disclose is the first storage medium and second storage medium are each an IC card containing electronic money information and key data unique to the IC card, and key data is encrypted using the unique IC card key data when the key data is copied to the first storage medium or second storage medium. However, Ginter disclose the storage medium is an IC card and contains encryption data contained within (See Ginter figures 6-8 and associated text and column 40, lines 62-68, column 41, lines 1-68, and column 42, lines 1-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter for better security and portability of usage rights management tools and authorization.

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23. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

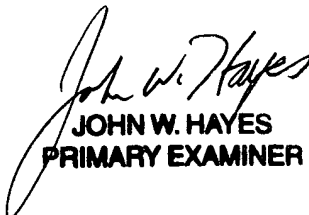
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
May 26, 2004**


**JOHN W. HAYES
PRIMARY EXAMINER**